UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,545	02/15/2007	Hannu Pirila	944-003.183-1	8661

4955   7590   01/21/2010
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EXAMINER
JAMA, ISAAK R

ART UNIT	PAPER NUMBER
2617	

MAIL DATE	DELIVERY MODE
01/21/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/563,545	PIRILA ET AL.
	Examiner	**Art Unit**	
	ISAAK R. JAMA	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>18 December 2009</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-22</u> is/are pending in the application.
     4a) Of the above claim(s) <u>2,7,13 and 16</u> is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1,3 -6, 8-12, 14, 15, and 17-22</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
     a)☐ All   b)☐ Some *   c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   Claim 9 is objected to because of the following informalities: Claim 9 is amended

as follows: "" A method according to claim 6, further comprising using service request

signaling that is unsupported by the network device operating in the first mode for being

forwarded in a transparent container, to the other network device for allowing the other

network device to decode the service request signaling and to initiate a service based

handover towards the other network device" and as earlier objected to, the claim still

recites "....*for forwarding in a transparent container,* to the other network device for

allowing the other network device to decode the service request signaling ....". The

underlined lacks any explanation in the Applicant's disclosure, and in the context of the

invention, as such; the Examiner is unable to interpret what the Applicant means by

<u>forwarding in a transparent container</u>. Appropriate correction is required.

Status of Claims

2.   Claims 1, 3, 5, 6, 9, 12, 14, 15 and 17 and 18-22 are amended.

3.   Claims 2, 7, 13 and 16 are cancelled.

4.   Claims 1, 3-6, 8-12, 14, 15 and 17-22 are pending.

Response to Arguments

5.   Applicant's arguments filed 10/09/2009 have been fully considered but they are

not persuasive. Applicant argues that the prior art (i.e. EP Application Number 1 076

463 A2 to Torabi and USPN 6,748,246 to Khullar) fails to teach sending a request to a

network device operating in a first mode and that the service is being unsupported.

Examiner disagrees with the Applicant's assertion. Torabi teaches a method of

operating in a network device which is a component of a multimode communication

system and which is operable to serve a multimode terminal in a first mode, the method

comprising: receiving service request signaling from the multimode terminal for

requesting a service in at least one of various modes supported by the multimode

terminal: said service being unsupported by the network device or by the multimode

terminal in the first mode **[Column 6, lines 13-14; i.e. upon receiving a request from**

the user for a service unavailable at the visited network], and handing over the

multimode terminal to another network device supporting a second mode and the

requested service **[Column 6, lines 14-17; i.e. the visited network send an inquiry to**

the subscriber's home network or supporting network depending upon the

residency of the service] in order to establish the service in the second mode for the

multimode terminal to receive the requested service from the other network device in

the second mode, the requested service being supported by the multimode terminal in

the second mode **[Column 6, the supporting network processes the received**

request by determining whether the service request can be implemented in one of

the service providing entities, if so, the data contained in the received message is

used by the identified service to provide the service]. Torabi teaches that his

invention solves the problem in which a roaming subscriber enters a service area in

which the *requested service* by the subscriber and which is authorized by his/her home

network is _not supported_ by the visited network, because the requested service may for

example, not available **[Page 1, paragraph 0003]**. And in regard to the Khullar

reference, it is in the same endeavor as Torabi and the Applicant's claimed invention,

and it is introduced by the Examiner because it is combinable with Torabi's disclosure

and because Khullar teaches multimode equipment.

6.   Examiner's earlier rejection therefore stands.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 1, 3-6, 8-12, 14, 15 and 17-22 are rejected under 35 U.S.C. 103(a) as

being unpatentable over European Patent Application Number 1 076 463 A2 (Torabi) in

view of U.S. Patent Number 6,748,246 (Khullar).

8.   Regarding claims 1, 6, 9, 12, 15, 18 and 20-22, Torabi teaches a method of

operating in a network device which is a component of a multimode communication

system and which is operable to serve a multimode terminal in a first mode, the method

comprising: receiving service request signaling from the multimode terminal for

requesting a service in at least one of various modes supported by the multimode

terminal: said service being unsupported by the network device or by the multimode

terminal in the first mode **[Column 6, lines 13-14; i.e. upon receiving a request from**

the user for a service unavailable at the visited network], and handing over the

multimode terminal to another network device supporting a second mode and the

requested service **[Column 6, lines 14-17; i.e. the visited network send an inquiry to**

the subscriber's home network or supporting network depending upon the

residency of the service] in order to establish the service in the second mode for the

multimode terminal to receive the requested service from the other network device in

the second mode, the requested service being supported by the multimode terminal in

the second mode **[Column 6, the supporting network processes the received**

request by determining whether the service request can be implemented in one of

the service providing entities, if so, the data contained in the received message is

used by the identified service to provide the service]. But Torabi does not

specifically teach that the terminal is a multimode terminal or the services are in

different modes. Khullar teaches a method and apparatus for selecting an access

technology in a multi-mode terminal **[Title]**, whereby a multi-mode terminal **[Figure 3]**

with three access technologies (i.e. modes), such as GSM, W-CDMA and Edge-

Compact, and that if a network connection can be maintained using W-CDMA at the

radiated power level RPL B, and using EDGE Compact at the radiated power level RPL

C, the multimode terminal would select W-CDMA as the optimal AT (access technology)

[Column 5, lines 10-13]. Therefore, it would have been obvious to a person of ordinary

skill in the art at the time the invention was made to include the multimode terminal and

method of Khullar into the network system of Torabi in order to facilitate user requests in

different access systems.

9.   Regarding claims 3, 8, 14, 17 and 19, Torabi further teaches a method, system

and apparatus where that the network device is using service request signaling

messages that as such are used for services supported in the first mode, but using

signaling parameter code points indicating a specific service that is not supported by the

network device or by the multimode terminal in the first mode **[Column 4, lines 13-17;**

i.e. the mobile subscriber unit transitions from one network to a new serving

network, and discovers that this network cannot support the services for which

the mobile subscriber unit has subscribed] but the specific service being supported

by another system operating in the second mode **[Column 5, lines 44-50; i.e. the**

supporting network is optionally equipped with the full set of service providing

functional entities. This enables the supporting network to implement any feature

that is desired and subscribed by a subscriber, and make it available at a mobile

communication unit roaming outside its home network].

10.   Regarding claims 4, 5, 10 and 11, Khullar further teaches a method wherein the

service request signaling is triggered by a multimode terminal originated service

establishment request **[Column 3, lines 48-55; i.e. a first multi-mode terminal, e.g., a**

mobile station (MS), is communicating with a second multi-mode terminal, e.g.,

one or more base stations (BS), within a communicating network. Both the MS

and the BS are capable of transmitting and receiving information within the

network using various AT links, e.g., W-CDMA, GSM, and EDGE Compact].

Conclusion

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to ISAAK R. JAMA whose telephone number is (571)270-

5887. The examiner can normally be reached on Monday-Thursday; 4-10.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Lester G. Kincaid can be reached on (571) 272-7922. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/IRJ/

/LESTER KINCAID/

Supervisory Patent Examiner, Art Unit 2617